IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appeal No: **Unassigned**

In re the Application of: **Tominari ARAKI et al.**

Confirmation No.: **3883**

Serial Number: **10/056,973**

Group Art Unit: **1774**

Filed: **January 25, 2002**

Examiner: **DICUS, TAMRA**

For: **OPTICAL MEMBER**

Atty. Docket No.: 020611
Customer No.: 38834

SUBMISSION OF APPEAL BRIEF

Sir:

April 24, 2006

An Appeal Brief and a Petition for a one-month extension of time are submitted with this paper.

In the event this paper is not timely filed, appellant hereby petitions for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 50-2866, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,

ARMSTRONG, WESTERMAN & HATTORI, LLP

Nicolas E. Seckel
Attorney for Appellants
Reg. No. 44,373

1250 Connecticut Avenue NW Suite 700
Washington, DC 20036
Tel: (202) 822-1100
Fax: (202) 822-1111

NES:rep
Enclosure: Appeal Brief, Petition for Extension of Time

THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPEAL BRIEF FOR APPELLANT

Ex parte Tominari ARAKI et al.

Serial No.: 10/056,973

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Examiner: Tamra DICUS

Nicolas E. Seckel
Reg. No. 44,373
Attorney for Appellant

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 Connecticut Ave., N.W. Suite 700
Washington, DC 20036
Tel: (202) 822-1100
Fax: (202) 822-1111

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APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

April 24, 2006

Applicants appeal the September 21, 2005 Final Rejection of claims 10-51.

Applicants (now referred to hereinbelow as "appellants") filed a Notice of Appeal on January 23, 2006.

I. REAL PARTY IN INTEREST

The real party in interest is the assignee of the subject application, which is:

NITTO DENKO CORPORATION
1-2, Shimohozumi 1-chome
Ibaraki-shi, Osaka 567-8680 JAPAN

II. RELATED APPEALS AND INTERFERENCES

Appellants know of no other appeals or interference proceedings related to the present appeal.

III. STATUS OF CLAIMS

Claims 1-9 have been canceled. Pending claims 10-51 stand rejected. No claims are allowed or only objected to. The claims on appeal are claims 10-51. Claims 10 and 30 are the only independent claims.

IV. STATUS OF AMENDMENTS

An Amendment was filed on November 28, 2005 subsequent to the Final Rejection, canceling claims 13 and 32 and amending claims 10, 20-22, 30, and 39-41. Entry of the Amendment is respectfully requested, as indicated in the December 14, 2005Advisory Action.

The claims on appeal after entry of the amendment will be claims 10-12, 14-31, and 33-51. Claims 10 and 30 will be the only independent claims.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed invention relates to an optical member with an easy-releasing protective member. The easy-releasing protective member comprises a portion comprising an ink information for identification and another portion without the ink information.

An optical transmittance of the portion comprising the ink information is no less than 90% and up to 100% of an optical transmittance of said portion without the ink information

In addition, in the invention as claimed in claim 30 and its dependent claims, an optical transmittance of the portion without the identification information in the protective member is no less than 80%.

In particular, as recited in claims 1 and 30, the optical member comprises an optical material comprising at least one of a polarizing plate, retardation plate and a brightness enhanced plate. The easy-releasing protective member is provided on at least one side of front side and back side on the optical material.

The basic feature of the invention is explained for example on page 4, last full paragraph of the specification with reference to Figure 1. An easy-releasing protective film 1 is adhered to an optical material 2 through adhesive layer 11. Ink information 13 is applied to the protective film 1.

As indicated in the paragraph bridging pages 4-5, the optical material can include any of polarizing plate, a retardation plate, and a brightness enhanced plate.

A transmittance of the portion without the ink information is mentioned on page 14, first full paragraph. A transmittance of the portion with the ink information is mentioned in the paragraph bridging pages 15-16.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellants appeal the following rejections:

(1) Rejection of claims 10-21, 25-40, and 44-51 under 35 U.S.C. §103(a) as obvious over US 6,654,085 to Koike et al. ("Koike") in view of US 3,763,356 to Berler ("Berler"), and

(2) Rejection of claims 22-24 and 41-43 are rejected under 35 U.S.C. 103(a) as obvious over Koike in view of Berler, further in view of US 4,812,034 to Mochizuki ("Mochizuki").

VII. ARGUMENT

Appellants explain herein why each obviousness rejections should be reversed.

A. Rejection of claims 10-21, 25-40, and 44-51 under 35 U.S.C. §103(a) as obvious over US 6,654,085 to Koike et al. ("Koike") in view of US 3,763,356 to Berler ("Berler")

The claims are considered as a group. Claims 1 and 30 are the only independent claims of the group. It is noted that claims 13 and 32 have been canceled.

The Examiner has failed to establish a prima facie case of obviousness. In particular, the Examiner has not identified any motivation to combine Koike and Berler in a manner to result in the presently claimed invention.

1. The Examiner has not identified any motivation to combine derived from the teachings of the cited references

The references themselves do not provide a suggestion or motivation to select these references for combination. In particular, Koike is completely silent as to identifying its optical element. Further, Berler discloses a readable document of the card-type that carries ink information, but Berler is completely silent as to applying ink information to an optical material as in Koike, let alone an easy-releasing protective film of an optical material.

a. Koike does not teach or suggest identifying its optical element

Koike discloses a light scattering film having substrates on both sides, with at least one of the substrates being peelable. See Koike at col. 2, lines 27-34. The peelable substrate(s) make it possible to provide the light scattering film "built into" a liquid crystal display unit for improved optical properties. See Koike at col. 3, lines 10-19.

Koike is completely silent regarding identification of its optical element. This point is acknowledged by the Examiner. In particular, the Examiner acknowledges that "Koike does not

teach the easy-releasing protective member comprises ink where ink emits fluorescence." See Sept. 21, 2005 Final Office Action at page 3, lines 4-5 from the bottom.

b. Berler does not teach or suggest applying ink information to an optical material such as a polarizing, retardation, or brightness enhanced film

Berler discloses a machine readable document such as a tape, card, ticket, etc., which is made of translucent material on which coded information is printed with fluorescent ink. The document is read by a machine comprising a source of UV light and a sensor. See Berler at col. 2, lines 18-36. The document of Berler incorporates a UV filter, so that the document is readable from one side only. See Berler at col. 3, line 58 to col. 4, line 2.

Specifically, UV light 44 is blocked by filter 37, so that, when the document is in the proper position, only the fluorescent light generated by fluorescent ink 41 is transmitted to the sensor 42. See Berler at col. 5, lines 14-34 and Fig. 5.

The document of Berler is intended to replace traditional machine readable documents such as punch cards, see Berler at col. 1, lines 10-21, and over bi-directionally readable fluorescent ink-imprinted documents, see Berler at col. 1, lines 55-61.

The document of Berler does not require any particular optical property except translucence and UV filtering capacity. Thus, Berler is completely silent as to applying an ink information to an optical material such as a polarizing plate, a retardation film, or a brightness enhanced film.

c. Berler does not teach or suggest provisional identification of a substrate

Berler focuses on improving a document whose purpose is to carry information permanently, which requires permanent markings, as in an arrangement of holes in punch card, or an arrangement of permanent ink information. Thus, Berler cannot provide a motivation to

apply its fluorescent ink to an easy-releasing protective film, which is intended to be removed, because this would destroy the purpose of the document according to Berler.

d. Summary

In summary, the Examiner has failed to identify any suggestion or motivation to combine in the cited references themselves.

2. The Examiner has not identified any motivation to combine derived from the knowledge of persons of ordinary skill in the art

Berler discloses a machine-readable document with fluorescent ink. Koike discloses a diffusing film with easy-releasable substrate on one or both sides. The Examiner has alleged that "the same materials are used" for the substrate of Berler and the protective film of Koike. See December 14, 2005 Advisory Action at page 2. Even if this were true, and if this were to be recognized by a person of ordinary skill in the art, such recognition could not, in itself, provide a motivation to combine the references as alleged by the Examiner.

3. The Examiner has not identified any motivation to combine derived from the nature of the problem to be solved

A combination of Koike and Berler cannot be derived from a problem to be solved, in particular because these references address completely different problems. On the one hand, Koike provides an easy-release substrate mainly to facilitate the incorporation of its diffusing film into a display, but is completely unconcerned with identifying its optical element. On the other hand, Berler attempts to improve on the readability of a coded information-carrying document, by providing the information in the form of fluorescent ink together with a UV filter in the document, so that the document is readable unidirectionally only.

Without hindsight, it is impossible to identify a reason why a person of ordinary skill, in attempting to identify an optical member comprising an optical material of the type as recited in present claims 1 and 30, would be motivated to refer to a card-type data carrier as in Berler.

4. The Examiner's purported motivation to combine is legally insufficient

In the final Office Action, the Examiner acknowledges that "Koike does not teach the easy-releasing protective member comprises ink where ink emits fluorescence," see September 21, 2005 Final Office Action at page 3, lines 4-5 from the bottom, but the Examiner alleges that there would have been a motivation to provide ink information on the easy-releasing protective member of Koike "because Berler teaches printed fluorescent ink imprinted on transparent substrates such as cellulose acetate (col. 3, lines 15-31 of Berler) for identifying purposes." See Id. at page 6, lines 1-2 from the bottom.

Also, the Examiner alleges that "the secondary reference [Berler] is used to show printing on top of a cellulose acetate substrate is performed for identification purposes and the primary reference [Koike] is used to teach the structure." See Id. at page 6, lines 5-7 from the bottom. This falls short of providing a motivation to combine because any similarity in the materials used, even if correct, would be insufficient to provide a motivation to apply ink to an optical member comprising an optical material as in the presently claimed invention, let alone to an easy-release film.

The Examiner's deficient case of obviousness is remarkably similar to the situation in In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998), where the Court reversed a determination of obviousness in the absence of a suggestion or motivation to combine the cited references. See M.P.E.P. §2143.01.

In Rouffet, the application claimed a low orbit satellite communications system for mobile terminals. Prior to the invention, conventional systems used several intersecting spot-shaped beams to cover an area. As the satellite or the mobile terminal user moved, the system would "hand over" the mobile terminal from one beam to another. Rouffet's invention was to provide beams with a fan-shape, so as to minimize handover due to the satellite's movement.

The Examiner cited primary references King and Rosen for teaching the use of a network of satellites in low Earth orbit, and secondary reference Ruddy for teaching a fan-shape beam for transmitting from the Earth to a satellite in a specific orbit ("Molniya orbit").

The Federal Circuit accepted the Examiner's and the Board's position that shifting the frame of reference Earth-satellite (as in Ruddy) to satellite-Earth transmission (as in the invention) was within the skill in the art. However, the Federal Circuit found that "the Board did not identify any motivation to choose these references for combination." Rouffet at 1457. Specifically, the Board noted that Ruddy "addresses the handover problem with an orbit selection, not a beam shape." Id. Accordingly, the Board concluded that the rejection for obviousness was based on hindsight, not a proper motivation to combine the references.

Similarly, here, on the one hand, a problem of the optical art was how to identify an optical film such as a polarizing film, a retardation film, or a brightness enhancement film, during its processing. On the other hand, fluorescent ink was known to enable unilateral reading of information on permanent cards, as found in Berler. Berler provided its ink to ensure unilateral reading. There is of course no suggestion in Berler that its ink might be applied to an easy-release layer for the purpose of identifying an optical material.

In Rouffet, the existence of fan-shaped beams for Molniya orbit transmission systems was held insufficient to provide a motivation to use fan-shaped beams in a system for tracking

mobile terminals. Similarly, here, the existence of fluorescent ink for unilateral reading of a permanent card is not sufficient to provide a motivation to modify an easy-release layer of an optical film.

In particular, similarly to Rouffet, where the fan-shaped beam of the prior art tracked the specific Molniya orbit but did not address any "handover" problem with mobile terminals, here, the fluorescent ink of Berler permits unilateral reading of a card, but no problem of temporary identification of an optical element was raised in Berler.

5. Any combination of Koike and Berler would not result in the presently claimed invention

Even if, arguendo, a person of the art had found a motivation to refer to Berler to modify Koike, this would not have resulted in the presently claimed invention because the fluorescent ink would have been applied on the diffusing film directly and not on the easy-release substrate of Koike. Namely, an important feature of the information carrier of Berler is the conservation of data. Thus, a person of ordinary skill in the art would not have applied ink to a substrate which is intended to be discarded at the time the diffusing film is used.

6. Conclusion

In summary, the Examiner has not identified any motivation to combine the references, either in the nature of the problem to be solved, the teachings of the prior art, or the knowledge of persons of ordinary skill in the art.

This is particularly apparent in the Advisory Action, where the Examiner comments that "Applicant has not shown by objective evidence that the combination would not arrive at the instant invention." See December 14, 2005 Advisory Action at page 2. It is noted that, in the

Advisory Action, the Examiner still fails to provide any motivation for the alleged combination of references.

In addition, as discussed above, even if, arguendo, the Examiner had set forth a prima facie motivation to combine, this would not have resulted in the features of the presently claimed invention.

In view of the above, appellant solicits the reversal of the obviousness rejection of claims 10-21, 25-40, and 44-51 under 35 U.S.C. §103(a).

B. Rejection of claims 22-24 and 41-43 are rejected under 35 U.S.C. 103(a) as obvious over US 6,654,085 to Koike et al. ("Koike") in view of US 3,763,356 to Berler ("Berler"), further in view of US 4,812,034 to Mochizuki ("Mochizuki")

The claims are considered as a group.

Like Koike, Mochizuki is completely silent regarding identification of its optical films during processing, and it is completely silent in particular as to providing any markings or ink information. Therefore, Mochizuki fails to remedy the deficiencies of Koike and Berler discussed above, which discussion is hereby incorporated herein in its entirety. As a result, the Examiner has failed to establish a prima facie case of obviousness.

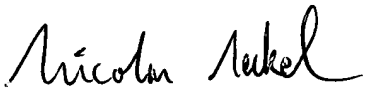
In view of the above, appellants solicit the reversal of the obviousness rejection of claims 22-24 and 41-43 under 35 U.S.C. §103(a).

VIII. CONCLUSION

For the above reasons, appellants request that the Board of Patent Appeals and Interferences reverse the Examiner's rejections of claims 10-12, 14-31, and 33-51.

In the event this paper is not timely filed, appellants petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 50-2866, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



Nicolas E. Seckel
Attorney for Appellant
Reg. No. 44,373

Atty. Docket No. 020611
Customer No.: 38834
1250 Connecticut Ave., N.W. Suite 700
Washington, DC 20036
Tel: (202) 822-1100
Fax: (202) 822-1111
NES:rep
Enclosures: Claims appendix
Evidence appendix
Related proceedings appendix

CLAIMS APPENDIX

1-9. (Canceled)

10. (Currently amended): An optical member comprising:

an optical material comprising at least one of a polarizing plate, retardation plate and a brightness enhanced plate; and

an easy-releasing protective member, said easy-releasing protective member comprising a portion comprising an ink information for identification and another portion without the ink information,

said easy-releasing protective member being provided on at least one side of front side and back side on the optical material,

wherein an optical transmittance of the portion comprising the ink information is no less than 90% and up to 100% of an optical transmittance of said portion without the ink information.

11. (Previously presented): The optical member according to claim 10, wherein an optical transmittance of a portion without the ink information in the protective member is no less than 80%.

12. (Previously presented): The optical member according to claim 10, wherein the identification information comprise an ink emitting fluorescence by an irradiation of ultraviolet light.

13. (Canceled)

14. (Previously presented): The optical member according to claim 10, further comprising a separator adhered to at least one side of the optical member.

15. (Previously presented): The optical member according to claim 10, further comprising an adhesive layer disposed on the optical member.

16. (Previously presented): The optical member according to claim 15, wherein the thickness of the adhesive layer is between 1 μm and 500 μm.

17. (Previously presented): The optical member according to claim 10, wherein the thickness of the easy-releasing protective member is at most 500 μm.

18. (Previously presented): The optical member according to claim 10, wherein the thickness of the easy-releasing protective member is between 5 μm and 300 μm.

19. (Previously presented): The optical member according to claim 10, wherein the thickness of the easy-releasing protective member is between 10 μm and 200 μm.

20. (Currently amended): The optical member according to claim ~~13~~ 10, wherein the optical material comprises a polarizing plate.

21. (Currently amended): The optical member according to claim ~~13~~ 10, wherein the optical material comprises a retardation plate.

22. (Currently amended): The optical member according to claim ~~13~~ 10, wherein the optical material comprises a brightness-enhanced plate.

23. (Previously presented): The optical member according to claim 22, wherein the optical material comprises a linearly reflective polarizer.

24. (Previously presented): The optical member according to claim 22, wherein the optical material comprises a cholesteric liquid crystal layer.

25. (Previously presented): The optical member according to claim 10, wherein the optical transmittance of the portion with the identification information is not less than 92% of the optical transmittance of the portion without the identification information.

26. (Previously presented): The optical member according to claim 10, wherein the optical transmittance of the portion with the identification information is not less than 94% of the optical transmittance of the portion without the identification information.

27. (Previously presented): The optical member according to claim 10, wherein the optical transmittance of the portion with the identification information is not less than 96% of the optical transmittance of the portion without the identification information.

28. (Previously presented): The optical member according to claim 10, wherein the optical transmittance of the portion with the identification information is different from the optical transmittance of the portion without the identification information.

29. (Previously presented): The optical member according to claim 10, wherein the identification information is arranged on the surface of the optical material.

30. (Currently amended): An optical member comprising:

an optical material comprising at least one of a polarizing plate, retardation plate and a brightness enhanced plate; and

an easy-releasing protective member comprising a portion comprising an identification information and another portion without the ink information,

said easy-releasing protective member being arranged on the surface of at least one side of front and back side on an optical material,

wherein an optical transmittance of the portion without the identification information in the protective member is no less than 80%, and an optical transmittance of the portion comprising the identification information is no less than 90% and up to 100% of an optical transmittance of said portion without the identification information.

31. (Previously presented): The optical member according to claim 30, wherein the identification information comprises a identification emitting fluorescence by an irradiation of ultraviolet light.

32. (Canceled)

33. (Previously presented): The optical member according to claim 30, further comprising a separator adhered to at least one side of the optical member.

34. (Previously presented): The optical member according to claim 30, further comprising an adhesive layer disposed on the optical member.

35. (Previously presented): The optical member according to claim 34, wherein the thickness of the adhesive layer is between 1 μm and 500 μm.

36. (Previously presented): The optical member according to claim 34, wherein the thickness of the easy-releasing protective member is between 5 μm and 300 μm.

37. (Previously presented): The optical member according to claim 30, wherein the thickness of the easy-releasing protective member is between 5 μm and 300 μm.

38. (Previously presented): The optical member according to claim 30, wherein the thickness of the easy-releasing protective member is between 10 μm and 200 μm.

39. (Currently amended): The optical member according to claim ~~32~~ 30, wherein the optical material comprises a polarizing plate.

40. (Currently amended): The optical member according to claim ~~32~~ 30, wherein the optical material comprises a retardation plate.

41. (Currently amended): The optical member according to claim ~~32~~ 30, wherein the optical material comprises a brightness-enhanced plate.

42. (Previously presented): The optical member according to claim 41, wherein the optical material comprises a linearly reflective polarizer.

43. (Previously presented): The optical member according to claim 41, wherein the optical material comprises a cholesteric liquid crystal layer.

44. (Previously presented): The optical member according to claim 30, wherein the optical transmittance of the portion with the identification information is not less than 92% of the optical transmittance of the portion without the identification information.

45. (Previously presented): The optical member according to claim 30, wherein the optical transmittance of the portion with the identification information is not less than 94% of the optical transmittance of the portion without the identification information.

46. (Previously presented): The optical member according to claim 30, wherein the optical transmittance of the portion with the identification information is not less than 96% of the optical transmittance of the portion without the identification information.

47. (Previously presented): The optical member according to claim 30, wherein the optical transmittance of the portion with the identification information is different from the optical transmittance of the portion without the identification information.

48. (Previously presented): The optical member of claim 10, wherein the portion with the ink information has an arbitrarily formed component.

49. (Previously presented): The optical member of claim 48, wherein the portion with the ink information has a component formed as a character, figure, sign, or color.

50. (Previously presented): The optical member of claim 30, wherein the portion with the ink information has an arbitrarily formed component.

51. (Previously presented): The optical member of claim 50, wherein the portion with the ink information has a component formed as a character, figure, sign, or color.

EVIDENCE APPENDIX

No evidence under 37 C.F.R. § 41.37(c)(1)(ix) is submitted.

RELATED PROCEEDING APPENDIX

No decisions under 37 C.F.R. § 41.37(c)(1)(x) are rendered.